

UTILITY PATENT

Docket No. P-US-TN1444

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEIn re application of: **Roger Q. SMITH et al.**Serial No.: **09/153,621**Examiner: **T. Dinh**Filed: **September 15, 1998**Group Art Unit: **2841**For: **HEAVY-DUTY AUDIO EQUIPMENT**Assistant Commissioner for Patents
Washington, DC 20231**RESPONSE TO OFFICE ACTION**

I, Adan Ayala, Reg. No. 38,373, certify that this
correspondence is being facsimile transmitted to the
Patent and Trademark Office Fax No. (703) 305-3431

on Sept 9, 2002

Adan Ayala**FAX COPY RECEIVED****SEP 09 2002**

Dear Sir:

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This is in response to the Office Action mailed July 3, 2002.

Currently in the application are Claims 1-6 and 15-20.

The Examiner has rejected Claims 1-6 under 35 USC § 102(b) as being anticipated
by US Patent No. 4,480,809 ("Healy"). This rejection is respectfully traversed.

Claim 1 calls for an audio equipment comprising a housing, an audio circuitry
installed within the housing, and a first protective bar flexibly connected to the housing.

Admittedly, Healy discloses a fishfinder including a housing containing sonar
circuitry, and that the housing is connected to a base 14. However, Healy does not

UTILITY PATENT

Docket No. P-US-TN1444

disclose any audio circuitry. Indeed, the Examiner notes that the audio circuitry is inherent to the sonar.

It is true that an inherent disclosure of a prior art reference may be relied upon in the rejection of claims under 35 USC § 102(b). MPEP § 2112, at 2100-51 (8th ed., Aug. 2001). However, to establish inherence, “the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” MPEP § 2112, at 2100-51 (*quoting In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Accordingly, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP § 2112, at 2100-52 (*quoting Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). However, the fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherence of that characteristic. MPEP § 2112, at 2100-51 (*citing In re Rikckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)).

In other words, the Examiner must show that audio circuit is necessarily found in all fishfinders circa 1982, i.e., the filing date of Healy. Why in all fishfinders? Because if the feature is not present in all fishfinders, then the feature is necessarily present in fishfinders, and thus cannot be considered inherent to fishfinders. In addition, the Examiner must show that the audio circuitry is necessarily within the housing, rather than outside of the housing. If the Examiner cannot provide such proof, then the Examiner should withdraw the rejection based on Healy.

In addition, base 14 is neither the protective bar called for in Claim 1, nor flexibly connected to the housing. As discussed in the specification, the protective bar is provided

UTILITY PATENT**Docket No. P-US-TN1444**

to protect the housing from being destroyed at a jobsite because of: (1) tools being dropped on the housing; or (2) the radio falling down.

In Healy, however, the base does not serve to protect the housing. For example, Applicant notes base 14 is "adapted to rest on a support surface or be affixed to a support surface such as a portion of a boat or the like." Healy, col. 2, lns. 19-22. In other words, the base 14 only serves to support the fishfinder in place. Therefore, the base 14 is not a "protective bar" as called for in Claim 1. Thus, Healy cannot anticipate Claim 1 and its dependent claims.

Furthermore, base 14 is not flexibly connected to the housing as called for in Claim 1. Such arrangement is critical and advantageous, as evidenced by the attached declaration of Michael L. O'Banion, a person of ordinary skill in the art. As discussed in the specification, the protective bar is flexibly connected to the housing for at least partially absorbing the shock occurring from: (1) tools being dropped on the housing; or (2) the radio falling down.

According to Healy, housing 10 has a trunnion 26 which receives resilient washer 30. A knob 34 has a screw 36 threadingly engaged to trunnion 26. A second resilient washer 38 is disposed between knob 34 and base 14. Accordingly, base 14 is sandwiched between resilient washers 30, 38, as shown in FIG. 2 of Healey. To fix the angular position of housing 10 relative to base 14, knob 34 is tightened, compressing washers 30, 38, which provide enough friction accordingly.

Because of this compression, base 14 is not flexibly connected to the housing. This is because the washers 30, 38 are so compressed that they cannot absorb any shock force occurring from: (1) tools being dropped on the housing; or (2) the housing falling down. This is not surprising, as none of these occurrences would occur on a sport

UTILITY PATENT

Docket No. P-US-TN1444

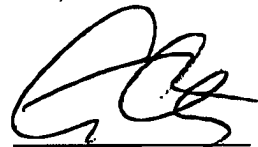
fishermen's boat, as construction tools are not carried in a boat and the fishfinder is likely to be bolted onto the boat, as disclosed in Healy. Accordingly, the Healy device would not require a protective bar flexibly connected to the housing.

By contradistinction, Claim 1 requires "a first protective bar flexibly connected to the housing." Since Healy does not teach or suggest such feature, it cannot anticipate Claim 1 or its dependent claims.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 1-6 and 15-20 are respectfully requested.

No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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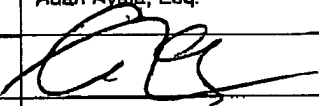
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	Group Art Unit	2841
	Examiner Name	T. Dinh
Total Number of Pages in This Submission	Attorney Docket Number	P-TN-1444

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Date	September 9, 2002

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